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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/887,978 | 06/22/2001 | William Gray | 1780/1D144-US2 | 9044 |

7590 10/08/2002

DARBY & DARBY P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

THALER, MICHAEL H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3731

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/887,978

Applicant(s)
Gray et al.

Examiner
Michael Thaler

Art Unit
3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 18, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-32 is/are pending in the application.
- 4a) Of the above, claim(s) 24-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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Applicant's election with traverse of invention I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the apparatus as claimed could not be used to practice another materially different process since the requirement in claim 22 that the guide wire be used to direct the catheter requires movement between the catheter and guide wire. This is not found persuasive because guide wires which are fixed to the catheter and extend distally beyond the distal end of the catheter to direct the catheter through the vasculature are well known in the catheter art. The requirement is still deemed proper and is therefore made FINAL.

Claims 24-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The filter defined in claim 23, line 10 has already been defined in claim 22, resulting in a double recitation of the same element.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Mazzocchi (WO 96/01591). Mazzocchi, in figures 11A and 11B, shows catheter (e.g., the balloon catheter described on page 29, lines 6-13), guide wire 260 and collapsible filter 270.


Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzocchi (WO 96/01591). Mazzocchi, in figures 11A and 11B, shows tubular shaft 274, core wire 260 and collapsible filter 270. Mazzocchi fails to specifically indicate that tubular shaft 274 is flexible as claimed. However, Mazzocchi indicates that the shaft 274 may be formed of a thin walled hypotube (page 29, lines 28-31) which obviously is flexible since thin walled hypotubes are typically flexible due to the thinness of their walls.

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Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzocchi (WO 96/01591) in view of Gunther et al. (5,329,942). Assuming *arguendo* that tubular shaft 274 of Mazzocchi is not flexible, it is noted that the mechanism to expand and collapse the Mazzocchi filter is complicated and includes numerous tethers 290. Gunther et al. teach that a collapsible vascular filter may be expanded and collapsed by the simple relative slidable displacement between a core wire 15 and flexible shaft 19 (col. 5, lines 37-47). Including a similar core wire and flexible shaft with the Mazzocchi filter in order to provide a simpler mechanism to expand and collapse it would have been obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht
September 27, 2002
FAX (703) 305-3590


MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731